



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,495	07/31/2003	Brian K. Aegerter	6884-66364	4402
7590 05/10/2006			EXAMINER	
One World Trade Center Suite 1600 121 S.W. Salmon Street Portland, OR 97204			VINH, LAN	
			ART UNIT	PAPER NUMBER
			1765	

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/632,495

Applicant(s)

AEGERTER ET AL.

Examiner

Lan Vinh

Art Unit

1765

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 10 and 12.
Claim(s) rejected: 1-9, 11, 13-24, 26-34, 52-59 and 65-71.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Lan Vinh
AU 1765

Response to Arguments

1. Applicant's arguments filed 4/24/2006 have been fully considered but they are not persuasive.

In the previous office action, the examiner considers the priority date of this application is September 28, 2000 because it is noted that the MPEP section 2133.01 states "When applicant files a continuation-in-part whose claims are not supported by the parent application, the effective filing date is the filing date of the child CIP. Any prior art disclosing the invention or an obvious variant thereof having a critical reference date more than 1 year prior to the filing date of the child will bar the issuance of a patent under 35 U.S.C. 102(b). *Paperless Accounting v. Bay Area Rapid Transit System*, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986)" and since the present application is a division of U.S Patent Application No. 09/672,572 (Child) filed September 28, 2000, now U.S. Patent No. 6,632,292, which is incorporated herein by reference, which is a continuation-in-part of copending U.S. Patent Application no 09/437,926 (Parent) filed November 10, 1999, accordingly, the effective filing date is the filing date of the child September 28, 2000. The applicants argue that regardless of the fact that there is a continuation-in-part in the priority chain of the present application, because all of the features of all of the claims of the present application are supported by the grandparent patent and the great grandparent PCT application, the priority date for the claims at issue is at least as early as March 15, 1999 (the PCT application filing date); thus, the March 15, 1999 priority date applies to the present claims and pre-dates the Miki reference (effective filing date May 17, 1999). The applicants then provide examples of

Art Unit: 1765

such support in the grandparent, US patent '436 and its parent PCT (International Patent Application No. PC-1-*599/05674) (the great-grandparent application) of which the *436 patent is a continuation, as follows:

Claim 1 - supported throughout the '436 patent such as at col. 2, lines 28-42, col 4, lines 38-49; col. 5, lines 58-62; col. 6, lines 6-19; etc.

Claim 2 - same as claim 1 and col. 7, lines 23-30.

Claim 3 - same as claims 1 and 2.....Claims 65-71.....patents

This argument is unpersuasive because a review of the cited portions in the "436" patent reveal that some of the features of the claims of the present application are not supported by the grandparent patent. For example, claim 1 requires "while excluding at least a major portion of the second side from exposure to the first fluid" and col 5, lines 58-62 of "436" discloses "contact of a processing liquid at a first side of a workpiece and at only a peripheral margin portion of the second side thereof" while it is noted that "Any negative limitation or exclusionary proviso must have basis in the original disclosure.

If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977)", MPEP 2173.05(i). Claim 3 requires "wherein the first and second fluids are supplied at different time periods", a review of the cited portions in the "436" (same as claims 1 and 2) patent reveals that there is no support for "wherein the first and second fluids are supplied at different time periods". Because some of the claims are not supported by the parent application (MPEP& 2133.01), 319) and the MPEP section 2133.01 states "When applicant files a continuation-in-part whose claims are not

Art Unit: 1765

supported by the parent application, the effective filing date is the filing date of the child CIP. Any prior art disclosing the invention or an obvious variant thereof having a critical reference date more than 1 year prior to the filing date of the child will bar the issuance of a patent under 35 U.S.C. 102(b). *Paperless Accounting v. Bay Area Rapid Transit System*, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986)" and since the present application is a division of U.S Patent Application No. 09/672,572 (Child) filed September 28, 2000, now U.S. Patent No. 6,632,292, which is incorporated herein by reference, which is a continuation-in-part of copending U.S. Patent Application no 09/437,926 (Parent) filed November 10, 1999, accordingly, the effective filing date is the filing date of the child September 28, 2000. Thus, it is asserted that Miki is qualified as prior art against the present claims

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Vinh whose telephone number is 571 272 1471. The examiner can normally be reached on M-F 8:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571 272 1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1765

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'LV' followed by a stylized flourish.

LV

May 5, 2006